

# Office Action Summary

Application No.

10/047,835

Applicant(s)

CHOU ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,8,14 and 17 is/are rejected.
- 7) ☐ Claim(s) 3-7,9-13,15 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Claim Rejections - 35 USC § 112***

Claims 1, 2, and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for valuable substances, such as adipic acid, 6-hydroxycaproic acid saponified esters or ketones of cyclohexanol group and C<sub>4</sub>-C<sub>6</sub> lactones, does not reasonably provide enablement for all the valuable substances in the field of organic chemistry. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to all the valuable substances unrelated to the current invention commensurate in scope with these claims. Therefore, an appropriate correction is required.

Because the specification, while being enabling for nitrocompounds, such as NO and NO<sub>2</sub>, does not reasonably provide enablement for all the nitro compounds in the field of chemistry. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to all the nitro compounds unrelated to the current invention commensurate in scope with these claims. Therefore, an appropriate correction is required. Furthermore, there are "foreman factors or Wands factors" regarding unpredictability because nitrocompounds include heterocyclic compounds containing nitrocompounds, aromatic compounds containing nitrocompounds, alicyclic compounds containing nitrocompounds, and a diverse scope of acyclic compounds containing nitrocompounds. In addition, it does not exclude bi-functional groups containing nitrocompounds. Moreover, as the molecular weight

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varies substantially, therefore, not all nitrocompounds are gaseous and also more than routine experimentation is involved. See In re Armbruster 185 USPQ 204 (CCPA 1985) and Angstadt et al. , 190 USPQ 152 (CCPA 1990).

Because the specification, while being enabling for one oxidant other than nitric acid, such as hydrogen peroxide, perchloric acid or potassium permanganate, does not reasonably provide enablement for all the oxidants selected from the field of chemistry. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to all the oxidants unrelated to the current invention commensurate in scope with these claims. Therefore, an appropriate correction is required.

Claims 1 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 17 , terms, “ a pH value” and “valuable substances” are written. However, the pH value is not described and the valuable substances are not specified in the claims. Therefore, an appropriate correction is required.

In claims 8 ,14, and 17, terms, “ temperature of ” and “ absolute pressure of ” are written. However, an article “a” is absent in front of the words, “temperature” and “ absolute pressure. ” An appropriate correction is required.

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Claims 3-7 , 9-13, and 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

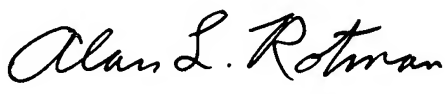
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 703-305-0809. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2742 for regular communications and 703-305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

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November 5, 2002

  
**ALAN L. ROTMAN**  
**SUPERVISORY PATENT EXAMINER**  
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